

REMARKS

Claims 1 to 22 were pending in the application at the time of examination. Claims 8 to 14 and 15 to 21 stand rejected as directed to non-statutory subject matter. Claims 1 to 22 stand rejected as obvious.

Claims 8 to 14 and 15 to 21 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicant respectfully notes that the claims have been previously examined three prior times over almost two-years and this rejection is being raised for the first time. Applicant also notes that no authority, either case law or the MPEP, is cited to support the rejection.

Nevertheless, to move prosecution forward, Applicant has amended Claim 8 to recite that the invention is embodied in a tangible system. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the § 101 rejection of each of Claims 8 to 14.

Similarly, Claims 15 to 21 have been amended to recite that the computer program product includes a tangible medium. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the § 101 rejection of each of Claims 15 to 21.

Claims 1 to 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,963,205, hereinafter referred to as Sotomayor.

Applicant respectfully traverses the obviousness rejection of Claim 1. Applicant respectfully notes that Claim 1 recites a specific sequence of operations, some of which are dependent upon results of other operations in the method. As discussed more completely below, the rejection does not address these interrelationships, and instead reduces the claim to a gist. Applicant notes that for an obviousness rejection, the MPEP directs:

THE CLAIMED INVENTION AS A WHOLE MUST BE CONSIDERED

MPEP § 2141.02, 8th Ed. Rev. 2, pg. 2100-124 (May 2004).

DISTILLING THE INVENTION DOWN TO A "GIST" OR "THRUST" OF AN INVENTION DISREGARDS "AS A WHOLE" REQUIREMENT

MPEP § 2141.02, 8th Ed. Rev. 2, pg. 2100-125 (May 2004).

The rejection first stated in part:

displaying a window including a list of index page types (Page Selection, elements 101-107, e.g., col. 10 lines 24-34, and fig. 7);

Sotomayor does not clearly show a list of index page types wherein the index page types include at least a table of contents and a bibliography. It would have been obvious to have the table of contents and the bibliography on the display to provide more information on one location to ease the users when searching or organizing data.

The rejection continued in part:

displaying a list of index line types for one page type upon selection of said one index page type in said list of index page types (levels, e.g., col. 10 lines 35-37, and fig. 7); although, Sotomayor does not shows [Sic] two separate windows for displaying index page types and index line types, it is well known and would have been obvious to separate into one or more tables to fit a particular set up window including a list of index page types (Page Selection elements 101-107, e.g., col. 10, lines 24-34, and fig. 7);

Thus, the rejection first identifies elements 101-107 in Fig. 7 as "a list of index page types" and next the rejection states that threshold levels for elements 101-107 are "a list of index line types for one page type." This is clear error and evidence that explicit claim limitations have not been considered. A threshold level for a particular element in

Sotomayor is not "a list of index line types for one page type." The fact that the rejection equates "a level" with a list establishes that neither explicit claim limitations nor the prior art has been considered as a whole.

In addition, the issue is not displaying tables to fit a particular window setup, but rather:

displaying a window including a list of index line types for one index page type **upon selection of said one index page type** (Emphasis added.)

Thus, the list of index line types are for one particular index page and are displayed upon selection of that one index page type. The rationale in the rejection has nothing to do with the explicit claim limitations. Spinners 111 to 117 that are used to set the levels are displayed irrespective of what element is chosen in elements 101 to 107. Thus, this is further evidence that both explicit claims limitations and the prior art reference have not been considered as a whole.

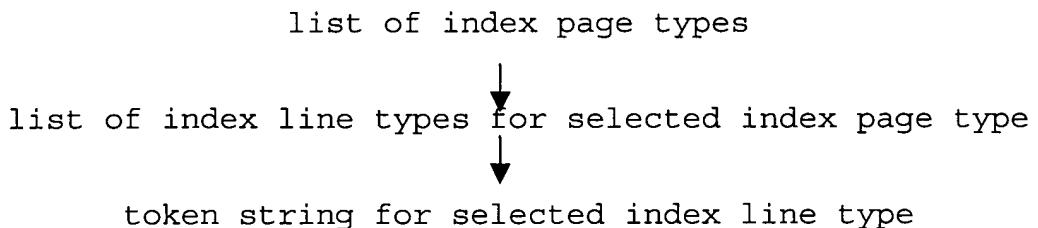
The rejection continued:

displaying a token string including a plurality of tokens for one index line type, upon selection of one index line type is said list of index line types (links and radio buttons, elements 109, 124, 126, 128, and 130, e.g., fig. 7), wherein said plurality of tokens includes only tokens appropriate for said one index line type (The user may also select (if only by default) a segment size at spinner 124, and may select other options by clicking at custom button 128, e.g., col. 10 lines 48-53);

Again, the rejection ignores explicit claim limitations. The rejection has not alleged or demonstrated that the cited elements are displayed based on any selections, and in fact are shown as simply displayed by default in the anchor page of Fig. 7. In contrast Claim 1, recites:

displaying a window . . . upon selection of said one index page type in said list of index page types;
displaying a token string . . . upon selection of said one index line type in said list of index line types,

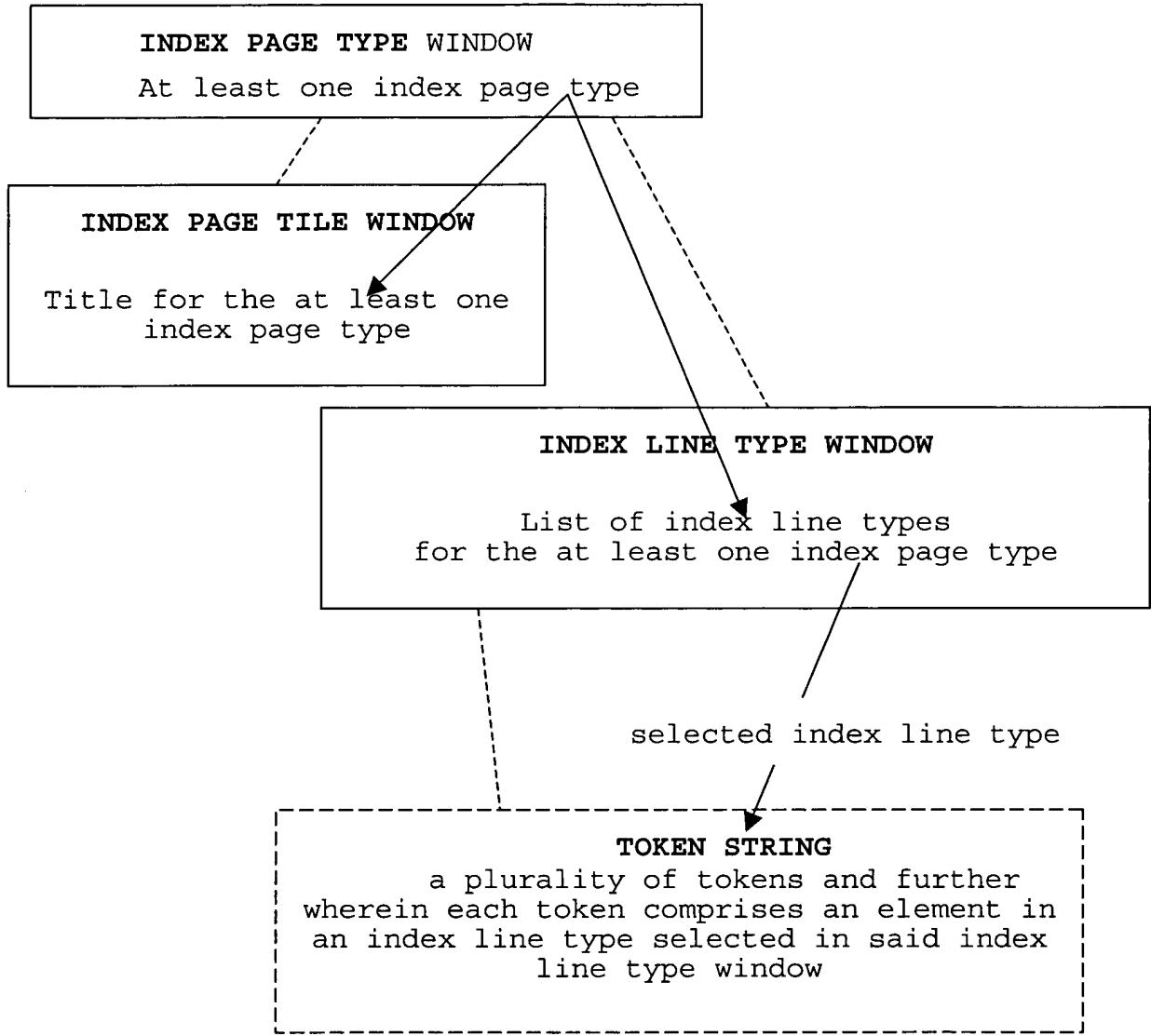
The claim is explicit upon when the elements are displayed. The rejection demonstrates that these explicit claims limitations have not been considered. Further, as noted above the rejection has not identified any hierarchy of elements in Fig. 7 as recited in Claim 1, e.g.



The rejection has failed to cite any teaching or suggestion that display of elements 109, 124, 126, 128, and 130 is contingent upon selection of two other elements in Fig. 7 of Sotomayor. Accordingly, the rejection fails to establish a *prima facie* obviousness rejection because neither the claim nor the prior art reference has been considered as a whole as required by the MPEP. Rather, the gist of the claim has been rejected, which is an improper form of analysis based upon the above quotation from the MPEP. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of Claim 1.

Claims 2 to 7 depend from Claim 1 and so distinguish over the cited reference for at least the same reasons as Claim 1, which are incorporated herein by reference. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 2 to 7.

With respect to the obviousness rejection of Claim 8, the relationships recited in Claim 8 can be represented as



where a dashed line indicates a coupling and an arrow represents a hierarchical relationship between the elements.

The rejection failed to cite any teaching of this hierarchical relationship and failed to cite any teaching or suggestion of the interrelations of the sub elements within the various elements. In addition, with the exception of the index page title window, the rejection of Claim 8 relies upon the rejection of Claim 1. Accordingly, the above comments with respect to Claim 1 are applicable and incorporated herein by

reference. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of Claim 8.

Claims 9 to 14 depend from Claim 8 and so distinguish over the cited reference for at least the same reasons as Claim 8, which are incorporated herein by reference. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 9 to 14.

With respect to Claim 15, the language discussed above with respect to Claim 1 is included in Claim 15. Therefore, the comments with respect to Claim 1, which are incorporated herein by reference, are directly applicable to Claim 15. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of Claim 15.

Claims 16 to 21 depend from Claim 15 and so distinguish over the cited reference for at least the same reasons as Claim 15, which are incorporated herein by reference. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 16 to 18 and 21.

With respect to Claim 22, the language discussed above with respect to Claim 1 is included in Claim 22. Therefore, the comments with respect to Claim 1, which are incorporated herein by reference, are directly applicable to Claim 22. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of Claim 22.

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Claims 1 to 22 remain in the application. Claims 8 and 15 have been amended. For the foregoing reasons, Applicant respectfully requests allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on July 8, 2005.


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July 8, 2005
Date of Signature

Respectfully submitted,



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